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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/699,221 Confirmation No.: 2799
First Named Inventor: Constantin Bulucea Filing Date: 31 October 2003
Group Art Unit: 2814 Examiner: Farahani, D.
Atty. Docket No.: NS-5127-1D US
Title: Design and Operation of Gate-Enhanced Junction Varactor With Gradual Capacitance Variation
Assignee: National Semiconductor Corporation

Mountain View, California
2 June 2005

COMMISSIONER FOR PATENTS
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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Restriction Requirement mailed 4 May 2005 for the above patent application.

The Restriction Requirement first asserts that the above application contains claims directed to the following fourteen patentably distinct species of the claimed invention:

- a. Figs. 8a - 8d and 10a - 10d;
- b. Figs. 9a and 9b;
- c. Figs. 12 and 19;
- d. Figs. 13 and 17;
- e. Fig. 14;
- f. Fig. 15;
- g. Figs. 16 and 21;
- h. Figs. 22 and 26;

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- i. Fig. 29;
- j. Fig. 32;
- k. Fig. 33;
- l. Fig. 34a;
- m. Fig. 34b; and
- n. Fig. 38

The Restriction Requirement then asserts that Applicant is required under 35 USC 121 to select a single one of the preceding species for prosecution on the merits to which the claims shall be restricted if no generic claim is found to be allowable. These assertions are not understood.

Figs. 9a, 9b, 12 - 17, 19, 21, 22, 26, 29, 32, 33, 34a, 43b, and 38, i.e., the figures of all the asserted species except the first asserted species (Figs. 8a - 8d and 10a - 10d), illustrate structures of implementations of the present gate-enhanced junction varactor or circuits that utilize the present gate-enhanced varactor. However, the above application only contains method claims. Structure Claims 1 - 60 were canceled in the Preliminary Amendment submitted in conjunction with the application filing papers on 31 October 2003 for revising the Text¹ so that method Claims 61 - 68 were pending immediately after filing of the above application. Since the figures of all the asserted species except the first asserted species illustrate structures of implementations of the present gate-enhanced junction varactor or circuits that utilize the present gate-enhanced varactor and since all of the claims pending immediately after filing of the above application were method claims, it would not have been possible immediately after filing of the above application to have elected any of the asserted species except possibly the first asserted species.

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¹ Claims 1 - 60 were cancelled via an instruction presented on page 2 of the 31 October 2003 Preliminary Amendment to Text. The subsequent listing of the claims inadvertently did not include Claims 1 - 60. In the event that a listing of Claims 1 - 60 should have been presented in the October 2003 Preliminary Amendment to Text, the appropriate PTO action would have been to inform Applicant's Attorney that the amendment was non-compliant and to have required that a paper be submitted to the PTO to make the amendment compliant. However, Applicant's Attorney believes that submission of a paper to make the October 2003 Preliminary Amendment to Text compliant is unnecessary now in view of the further submission described below.

To the extent that it might have been possible to elect the first asserted species immediately after filing of the above application, limiting the election to a single species amounts to no election at all. Accordingly, the requirement to elect one of the fourteen asserted species would have been inappropriate immediately after filing of the above application.

A Preliminary Amendment was submitted 9 May 2005 to add further method Claims 69 - 128. Although the Restriction Requirement apparently reached the office of Applicant's Attorney on 8 May 2005, Applicant's Attorney did not become aware of the Restriction Requirement until after the 9 May 2005 Preliminary Amendment was mailed out. In any event, method Claims 61 - 128 are now pending.

The situation with regard to electing one of the asserted species is now no different that it was immediately after filing of the above application. Because the figures of all the asserted species except the first asserted species illustrate structures of implementations of the present gate-enhanced junction varactor or circuits that utilize the present gate-enhanced varactor and because all the claims now pending are method claims, it is not possible at this time to elect any of the asserted species except possibly the first asserted species.

To the extent that it might now be possible to elect the first asserted species, limiting the election to a single species again amounts to no election at all. Consequently, the requirement to elect one of the fourteen asserted species is inappropriate and must be withdrawn.

The Restriction Requirement later asserts that restriction is required to one of the following inventions under 35 USC 121:

- I. Structure Claims 1 - 60; and
- II. Method Claims 61 - 68.

Since structure Claims 1 - 60 have been canceled and since the application only contains method claims, the requirement to restrict the above application to one of the asserted inventions is also inappropriate and must be withdrawn.

In short, the entire Restriction Requirement is inappropriate because only method claims are pending due to the prior cancellation of structure Claims 1 - 60. The Restriction Requirement must therefore be withdrawn.

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Respectfully submitted,

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